

1 Milord A. Keshishian, SBN 197835
milord@milordlaw.com
2 Kirstin Jensvold-Rumage, SBN 345916
kirstin@milordlaw.com
3 MILORD LAW GROUP P.C.
333 South Hope Street, Suite 4025
4 Los Angeles, CA 90071
Tel: (310) 226-7878
5 Fax: (310) 226-7879

6 Attorneys for Plaintiffs TIW Holdings LLC
7 And Puff Labs, LLC

8 **UNITED STATES DISTRICT COURT**
9 **CENTRAL DISTRICT OF CALIFORNIA**

10
11 TIW Holdings LLC, a Nevada limited
liability company; and, Puff Labs, LLC, a
12 Nevada limited liability company;

13 Plaintiffs,

14 v.

15 Hotbox Farms LLC, an Oregon limited
16 liability company; and DOES 1-10;
17 Defendant.
18

CASE NO.: 23-7980

COMPLAINT FOR DAMAGES:

1. Fraudulent Trademark Registrations
15 U.S.C. § 1120
2. Cancel Trademark Registrations
15 U.S.C. § 1119
3. Declaratory Judgment Of Non-
Infringement, Invalidity,
Unenforceability

JURY TRIAL DEMANDED

1 Plaintiffs TIW Holdings LLC (“TIW”) and Puff Labs, LLC (“Puff Labs”)
 2 (collectively “Puff TIW” or “Plaintiffs”) sue defendant Hotbox Farms LLC (“HFL” or
 3 “Defendant”), and DOES 1-10; and allege:

4 INTRODUCTION

5
 6 1. This is an action to stop an Oregon-based marijuana company from
 7 trademark bullying and enforcing an invalid trademark registration it knows was obtained
 8 by fraud on the United States Patent & Trademark Office (“USPTO”). With full
 9 knowledge that marijuana products are not eligible for federal trademark registration
 10 because they are an unlawful controlled substance under federal law and cannot be sold
 11 interstate, Defendant filed an application to fraudulently register the Hotbox Farms
 12 trademark in association with smoking paraphernalia it does not actually manufacture or
 13 sell. To perpetrate its fraud on the USPTO, Defendant merely took commercially
 14 available BIC® lighters and slapped on woefully improper “HOTBOX FARMS
 15 EASTERN OREGON” stickers to submit as a specimen of use in commerce, falsely
 16 declaring to the USPTO that the mark was “printed across the front of each lighter,” as
 17 shown below:



27 2. Despite Defendant’s knowledge of the invalidity of its fraudulently
 28 registered mark, it sent a cease-and-desist letter on September 8, 2023, to Plaintiffs

1 threatening litigation to “seek injunctive relief and recover monetary damages.” A copy
 2 of the correspondence is attached as EXHIBIT A. Plaintiffs are thus forced to turn to the
 3 Court to protect their rights and business and to prevent Defendant’s illicit conduct,
 4 including sending baseless cease-and-desist letters and threats of lawsuits arising from a
 5 fraudulently obtained trademark registration.

7 **JURISDICTION**

8 3. These causes of action arise under the provisions of the Lanham Act (15
 9 U.S.C. §§ 1051-1127) and California law. This Court has subject matter jurisdiction
 10 pursuant to 28 U.S.C. §§ 1331 and 1338 and 15 U.S.C. §§ 1114, 1119, 1120, and 1125.
 11 This Court has jurisdiction under the Federal Declaratory Judgment Act 28 U.S.C. §§
 12 2201-02. This Court has subject matter jurisdiction over the state causes of action under
 13 28 U.S.C. § 1367(a) because they are so related to claims within the original jurisdiction
 14 of this Court under the trademark and unfair competition laws of the United States that
 15 they form part of the same case or controversy.

16 4. Specifically, at all relevant times, Defendant has:

- 17 (a) advertised products sold under the purported “Hotbox Farms” mark in
 18 this District, including solicited articles in the Los Angeles Times
 19 newspaper and on the Fox 11 Los Angeles website promoting the
 20 purported “Hotbox Farms” mark at issue in the cease-and-desist letter,
 21 thus Defendant’s trademark building activities in California and this
 22 District are integral to the scope of the rights that are to be declared in
 23 this case;
- 24 (b) operated fully interactive retail ecommerce websites and storefronts that
 25 solicit and engage in regular business in California and this District,
 26 deriving a substantial volume—in dollars and units—and percentage of
 27 their business and revenue from sales to California and this District of
 28 products bearing the purported “Hotbox Farms” mark;

1 (c) placed products bearing the purported “Hotbox Farms” mark in the
2 stream of commerce and exploited the benefits of the California market
3 because they actively conducted transactions with California customers,
4 accepted payments from those customers, and imported and shipped
5 products bearing the purported “Hotbox Farms” mark into California and
6 this District;

7 (d) engaged in contractual relations and created continuing relationships and
8 obligations with California-based celebrities to market, sell, and
9 distribute products bearing the purported “Hotbox Farms” mark in
10 California and this District.

11 5. Venue in this judicial district is proper under 28 U.S.C. §1391(b) and (c)
12 because a substantial part of the events giving rise to the action occurred in this District,
13 including Hotbox Farms has, among other acts, marketed and sold in this District
14 products bearing the purported “Hotbox Farms” mark and because the Defendant’s
15 actions in fraudulently registering a trademark and unfair competition have resulted in
16 damages to TIW and Puff in this District.

17 THE PARTIES

18
19 6. Plaintiff TIW is currently a limited liability company organized and existing
20 under the laws of the State of Nevada, with a place of business in this District. Plaintiff
21 TIW is a holding company and owner of the HOTBOX trademarks.

22 7. Plaintiff Puff Labs is currently a limited liability company organized and
23 existing under the laws of the State of Nevada, with a place of business in this District,
24 and a licensee of the HOTBOX from TIW.

25 8. Hotbox Farms is currently a limited liability company organized and
26 existing under the laws of the State of Oregon, with a place of business at 325 NE
27 Goodfellow, Ontario, OR 97914.

28 9. Puff TIW is unaware of the true names and capacities of DOES 1 through

10, inclusive, and therefore sues said Defendants by such fictitious names. Puff TIW will ask leave of Court to amend this Complaint to state the true names and capacities of the Defendant sued as DOES when the same are ascertained. Puff TIW is informed and believes, and based thereon alleges that each of the fictitiously named Defendants are responsible in some manner for the occurrences herein alleged, and that Puff TIW's damages, as herein alleged, were proximately caused by their conduct.

10. Puff TIW is informed and believes, and on that basis alleges, that at all times relevant to this action, each of the Defendants was the agent, affiliate, officer, director, manager, principal, alter-ego, and/or employee of the remaining Defendants and was at all times acting within the scope of such agency, affiliation, alter-ego relationship and/or employment, and actively participated in or subsequently ratified and adopted, or both, each and all of the acts or conduct alleged herein with full knowledge of each and every violation of Puff TIW's rights and the damages to Puff TIW proximately caused thereby.

FACTUAL BACKGROUND

11. Puff began using the HOTBOX marks listed below on electronic vaporizers and e-liquid products in June of 2022, licensed from TIW.

12. TIW has three trademark pending trademark applications filed with the USPTO as noted below:

<u>TRADEMARK</u>	<u>SERIAL NO.</u>	<u>FILING DATE</u>	<u>CLASS/GOODS</u>
HOTBOX	97553218	08-17-2022	IC 003: Electronic cigarettes; Electronic cigarettes for use as an alternative to traditional cigarettes; Flavorings, other than essential oils, for use in electronic cigarettes; Liquid nicotine solutions for use in electronic cigarettes; Mechanical electronic cigarettes; E-juice and e-liquid products, namely, electronic cigarette liquid (e-liquid) comprised of flavorings in liquid

form, other than essential oils, used to refill electronic cigarette cartridges

IC 005: Dietary pet supplements in the form of pet treats; Dietary supplements; Dietary supplements for animals; Dietary supplements for promoting sleep, enhancing energy, relieving pain and enhancing focus; Nutritional supplements; Nutritional supplements for promoting sleep, enhancing energy, relieving pain and enhancing focus; Pain relief medication; Topical analgesics; Topical gel for medical and therapeutic treatment of aches and pains; Dietary supplemental drinks; Herbal drinks used to aid in sleep and relaxation; Herbal tinctures for medical purposes; Herbal supplements for promoting sleep, enhancing energy, relieving pain and enhancing focus; Non-medicated additives for animal feed for use as nutritional supplements; Powdered nutritional supplement drink mix; Preparation for the relief of pain; all of the foregoing containing CBD solely derived from hemp with a delta-9 tetrahydrocannabinol (THC) concentration of not more than 0.3 percent on a dry weight basis

IC 034: Electronic cigarettes; Electronic cigarettes for use as an alternative to traditional cigarettes; Flavorings, other than essential oils, for use in electronic cigarettes; Liquid nicotine solutions for use in electronic cigarettes; Mechanical electronic cigarettes; E-juice and e-liquid products, namely, electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form, other than essential oils, used to refill electronic cigarette cartridges

			<p>IC 035: Online retail store services featuring oils, beauty serums, lotions, creams, roll-ons, salves, hemp oil extracts, dietary supplements, dietary supplements for dogs, dog treats, and gummies; all of the foregoing are comprised of hemp containing less than 0.3 percent delta-9 tetrahydrocannabinol (THC) on a dry weight basis; Online Retail stores featuring topicals, namely, non-medicated salves, lotions, creams, and roll-ons, all for topical use, any CBD in the goods being featured or provided in the aforementioned services being solely derived from hemp with a delta-9 tetrahydrocannabinol (THC) concentration of not more than 0.3 percent on a dry weight basis; Retail store services featuring oils, beauty serums, lotions, creams, roll-ons, salves, hemp oil extracts, dietary supplements, dietary supplements for dogs, dog treats, and gummies; all of the foregoing are comprised of hemp containing less than 0.3 percent delta-9 tetrahydrocannabinol (THC) on a dry weight basis; Retail stores featuring topicals, namely, non-medicated salves, lotions, creams, and roll-ons, all for topical use, any CBD in the goods being featured or provided in the aforementioned services being solely derived from hemp with a delta-9 tetrahydrocannabinol (THC) concentration of not more than 0.3 percent on a dry weight basis</p>
HOTBOX 7500	97553220	08-17-2022	Same Goods / Services as listed above.
PUFF HOTBOX 7500	97553283	08-17-2022	Same Goods / Services as listed above

13. Puff TIW's HOTBOX common law trademarks and service marks will collectively be referred to as the "HOTBOX Marks."

14. As a result of Puff TIW's extensive advertising, promotion, sales, and continuous use, the HOTBOX Marks have acquired valuable goodwill among consumers and in the industry.

DEFENDANT'S MISCONDUCT

15. According to the USPTO's records, HFL is the recorded owner of Registration No. 7,062,602 (the "'602 Registration"), with an Intent to Use ("ITU") application filing date of October 28, 2020, for the following International Classes ("IC") and alleged goods/services and purported dates of use:

- a. IC 016: Stickers. First Use: 2016-10-31. First Use In Commerce: 2016-10-31
- b. IC 021: Insulating sleeve holder for beverage cups. First Use: 2018-06-30. First Use In Commerce: 2018-06-30
- c. IC 025: Hats; shirts; sweatshirts. First Use: 2016-10-31. First Use In Commerce: 2016-10-31
- d. IC 026: Buttons. First Use: 2018-06-30. First Use In Commerce: 2018-06-30
- e. IC 034: Lighters for smokers. First Use: 2016-10-31. First Use In Commerce: 2016-10-31
- f. IC 035: retail store services featuring hats, shirts, sweatshirts, buttons, stickers, beverage cozies, and lighters. First Use: 2016-10-31. First Use In Commerce: 2016-10-31

16. When HFL filed the application that issued as the '620 registration, HFL stated that it had a *bona fide* intention to use "HOTBOX FARMS" in commerce on or in connection with lighters for smokers in IC 34 and retail store services featuring hats, shirts, sweatshirts, buttons, stickers, beverage cozies, and lighters in IC 35.

1 17. In filing the application, HFL acknowledged to the USPTO that “willful
2 false statements, and the like, may jeopardize the validity of the application or any
3 resulting registration”

4 18. On June 29, 2021, the USPTO issued a notice of allowance, but instead of
5 filing a statement of use, HFL filed two extensions of time to file the statement of use,
6 specifically on December 28, 2021, and June 24, 2022.

7 19. Finally, on October 27, 2022, HFL filed its statement of use for the various
8 classes of goods/services, but with dates that inexplicably preceded the Intent to Use
9 application’s filing date and the specimens were fabricated by applying ornamental
10 stickers or drawings to products originating from third parties, not HFL. Further, the
11 specimens purporting to show use of the mark do not match the drawing of the mark, i.e.
12 “HOTBOX FARMS EASTERN OREGON” instead of “HOTBOX FARMS.”

13 20. Upon information and belief, HFL did not possess a *bona fide* intention to
14 use “HOTBOX FARMS” in commerce on or in connection with each and every one of
15 the goods listed in the application or did not provide the retail services for each of the
16 items listed when HFL filed the application on October 28, 2020.

17 21. Upon information and belief, HFL was not using “HOTBOX FARMS” in
18 commerce to identify each and every item listed in the Notice of Allowance when HFL
19 submitted the Statement of Use to the PTO on October 27, 2002, and, consequently, HFL
20 did not begin using “HOTBOX FARMS” in commerce to identify each and every item
21 listed in the Notice of Allowance at least as early as the dates provided, which are listed
22 in Paragraph 15 above.

23 22. In the Declaration, HFL, by and through its attorney, declared under the
24 penalty of perjury pursuant to 18 U.S.C. § 1001, that “the mark is in use in commerce on
25 or in connection with all the goods/services in the application or notice of allowance”;
26 “a(n) photograph of a display tray of lighters with the HOTBOX FARMS mark printed
27 across the front of each lighter”; and “[t]o the best of the signatory's knowledge,
28 information, and belief, formed after an inquiry reasonable under the circumstances, the

1 allegations and other factual contentions made above have evidentiary support.”

2 23. Upon information and belief, in truth and in fact, the mark was not in use in
3 commerce on or in connection with all the goods/services listed in the application or
4 notice of allowance and the purported HOTBOX FARMS mark was not printed across
5 the front of each lighter. HFL was not the source or origin of any lighters and merely
6 slapped on a sticker with an ornamental depiction of a marijuana leaf encircled with
7 “HOTBOX FARMS EASTERN OREGON” onto third-party BIC® lighters—without
8 any printing on the lighters, which could not function as a designation of source because
9 the source was third-party BIC®.

10 24. On December 19, 2022, the USPTO sent a Nonfinal Office Action refusing
11 registration because the “specimens of record is merely a decorative or ornamental
12 feature of the goods and, thus, does not function as a trademark to indicate the source of
13 applicant’s goods and to identify and distinguish them from others,” under Trademark
14 Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127.

15 25. The Office Action continued: “In this case, the mark as shown on the
16 specimens would be perceived as merely a decorative or ornamental feature of the goods.
17 Specifically, the submitted specimens for stickers, sleeve holders, buttons and lighters
18 show the applied-for mark, HOTBOX FARMS, located directly on the front portion of
19 the goods, where ornamental elements often appear. See TMEP §1202.03(a), (b).
20 Furthermore, the mark is displayed in a relatively large size on the goods such that it
21 dominates the overall appearance of the goods.”

22 26. The Office Action refused the specimen for IC 25, stating: “Additionally, the
23 submitted specimen for clothing shows the applied-for mark, HOTBOX FARMS, located
24 on the pocket or breast area of the clothing where trademarks often appear. However, the
25 tag inside the clothing shows another mark which appears to be ‘PORT & COMPANY.’
26 See https://www.portandcompany.com/p/3147_Charcoal#?doScrollToGrid=true. As
27 such, the other mark shown on the tag undermines the premise that HOTBOX FARMS
28 functions as a source-indicator.”

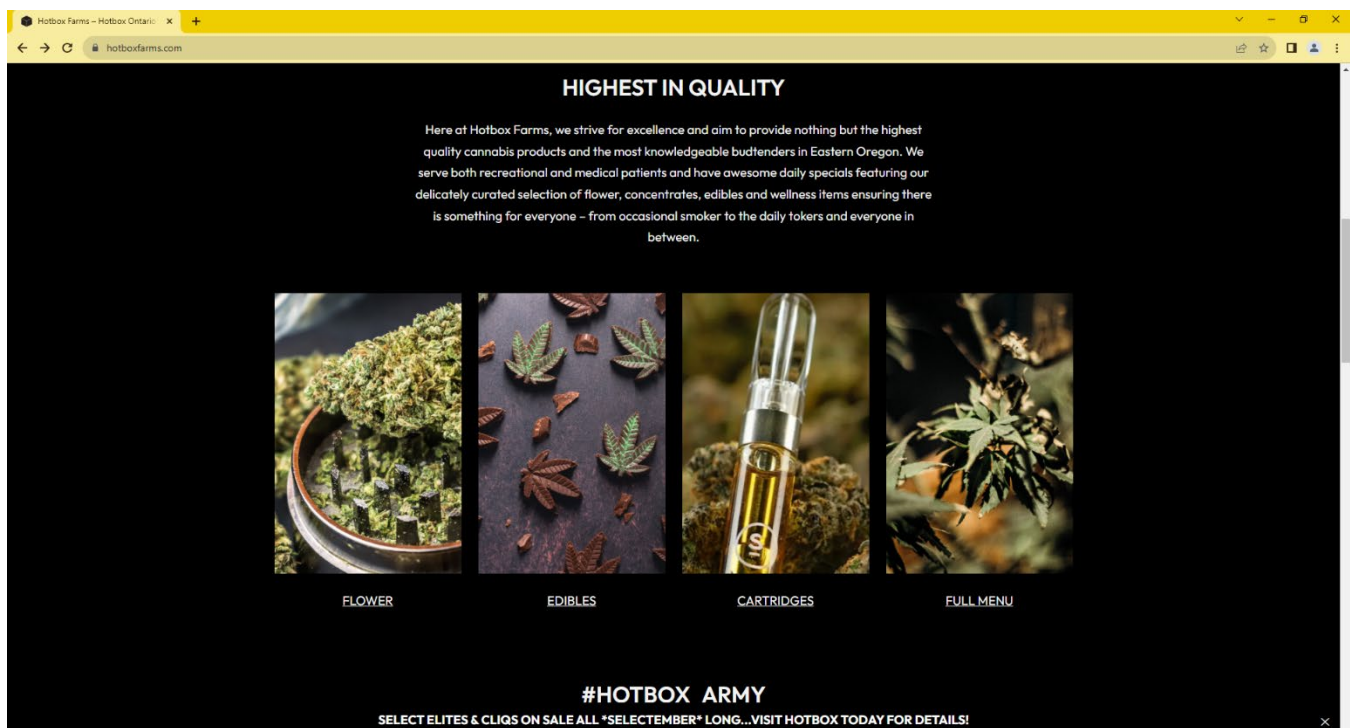
1 27. The Office Action further stated that the applied for mark “is used in a
2 merely decorative manner that would be perceived by consumers as having little or no
3 particular source-identifying significance. Therefore, consumers would view the applied-
4 for mark as a decorative or ornamental feature of the goods, rather than as a trademark to
5 indicate the source of applicant’s goods and to distinguish them from others.” The
6 examiner gave HFL four options to overcome the refusal to register, and are summarized
7 as follows: i) claim the mark has acquired distinctiveness under § 2(f) of the Lanham Act
8 by submitting sufficient evidence in support that the device is recognized by consumers
9 as a trademark; or, ii) submitting evidence that establishes that the public would
10 recognize applicant as the secondary source of or sponsorship for the goods; or, iii)
11 amend the application to the supplemental register; or, iv) submitting a substitute
12 specimen showing a non-ornamental trademark use.

13 28. On March 9, 2023, instead of responding to the substance of the Office
14 Action, HFL argued that because the “refusal does not apply to the services in class 35 of
15 the application,” and because “the examining attorney has accepted the specimen of use
16 and statement of use submitted by the applicant with respect to class 35,” thus “the
17 proposed mark serves as an identifier of secondary source, and the matter is registrable
18 on the Principal Register.”

19 29. But HFL withheld from the examining attorney the relevant information that
20 HFL had not in fact provided the services by selling all the products listed in IC 35 and
21 that the primary service provided by HFL was for the sale of controlled substances
22 prohibited by federal law, and HFL knew and was aware that marks used in connection
23 with marijuana and marijuana paraphernalia are not lawfully used in commerce under the
24 Lanham Act when it filed the application that would become the ‘602 Registration.

25 30. HFL was fully aware that the Controlled Substances Act “makes it unlawful
26 to sell, offer for sale, or use any facility of interstate commerce to transport drug
27 paraphernalia, i. e., ‘any equipment, product, or material of any kind which is primarily
28 intended or designed for use in manufacturing, compounding, converting, concealing,

1 producing, processing, preparing, injecting, ingesting, inhaling, or otherwise introducing
2 into the human body a controlled substance, possession of which is unlawful under [the
3 CSA],” and that the marijuana and marijuana paraphernalia it sells could not qualify for
4 registration under IC 35, otherwise it would not have filed for state trademark
5 registrations instead for its marijuana products. Indeed, HFL’s website does not list any
6 of the products listed in the application that issued as the ‘602 Registration, instead only
7 listing its marijuana products:



21 31. Puff TIW has no adequate remedy at law and is and will be irreparably
22 harmed unless Defendant’s conduct is preliminarily and/or permanently enjoined.

23
24 **FIRST CAUSE OF ACTION**
25 **Damages From Fraudulent U.S. Trademark Registrations (15 U.S.C. § 1120)**

26 32. Puff TIW refers to the allegations of Paragraphs 1 through 31 of this
27 Complaint and incorporates them as though fully set forth herein.

28 33. Under 15 U.S.C. § 1120, “[a]ny person who shall procure registration in the

1 USPTO of a mark by a false or fraudulent declaration or representation, oral or in
2 writing, or by any false means, shall be liable in a civil action by any person injured
3 thereby for any damages sustained in consequence thereof.” The Ninth Circuit has held
4 that “[a]ny person who has a reasonable interest to be protected against the use of
5 fraudulent statements in procuring a trademark registration—such as one who attempts to
6 sell, market, license, or commercially exploit any product with the same name as the
7 fraudulently procured trademark—may maintain a suit under Section 38 [15 U.S.C. §
8 1120].” *Official Airlines Guides, Inc. v. Goss*, 6 F.3d 1385, 1396 (9th Cir. 1993).

9 34. Defendant procured the ‘602 Registration for HOTBOX FARMS by false or
10 fraudulent declarations or representations. Specifically, Defendant falsely declared to the
11 USPTO that the “mark is in use in commerce” and/or that they were “entitled to use the
12 mark in commerce” on all goods/services listed in the application and statement of use
13 when it knew that the mark had not been used on all the goods/services. Defendant also
14 falsely presented to the USPTO that it was entitled to registration of the ornamental
15 designs by relying on the services listed in IC 35, while Defendant knew that it did not
16 provide services selling all the listed items in the application and that its primary business
17 could not qualify for federal trademark application because it was for the sale of
18 marijuana and marijuana paraphernalia in violation of the Controlled Substances Act,
19 which it withheld from the USPTO examining attorney. Further, as detailed above,
20 Defendant submitted doctored specimens that it knew were from third parties by applying
21 the purported mark thereon and misrepresenting to the USPTO that Defendant was the
22 source of those goods.

23 35. Had the USPTO not relied on Defendant’s material misrepresentations, it
24 would not have allowed registration of the purported HOTBOX FARMS trademark.

25 36. As a result of these false and/or fraudulent declarations and/or
26 representations made to the USPTO, Defendant was able to wrongfully procure the ‘602
27 Registration.

28 37. As a result of the illicitly registered trademarks, which registrations were

1 secured through the fraudulent scheme outlined above, Puff TIW has suffered damages in
2 that Defendant is now attempting to enforce its purported exclusive rights to prevent Puff
3 TIW's use of the HOTBOX Marks on their products to prevent fair competition and for
4 harassment of Puff TIW's supplier and customers.

5 38. By virtue of Defendant's ownership of the '602 Registration, Defendant
6 enjoys a false aura of exclusive rights in "HOTBOX FARMS" related marks, which it
7 used to threaten to disrupt Puff TIW's United States business operations. Puff TIW has
8 suffered damages based on at least diverted staff time and marketing expenses to counter
9 Defendant's use of the trademark registration to threaten Puff TIW's business. Puff TIW
10 has incurred monetary damages due to lost sales as a proximate result of Defendant's
11 false or fraudulent federal registrations, which it uses to threaten suppliers and customers.

12 39. Through the procurement of the federal '602 Registration by said false and
13 fraudulent declarations and representations, Defendant is liable to Puff TIW for damages
14 sustained in consequence thereof under 15 U.S.C. § 1120, which damages Puff TIW has
15 suffered and is continuing to suffer.

17 **SECOND CAUSE OF ACTION**

18 **Cancellation of U.S. Trademark Registrations (15 U.S.C. § 1119)**

19 40. Puff TIW refers to the allegations of Paragraphs 1 through 39 of this
20 Complaint and incorporates them as though fully set forth herein.

21 41. Section 1119 of the Lanham Act provides that in "any action involving a
22 registered mark the court may determine the right to registration, order the cancelation of
23 registrations, in whole or in part, restore canceled registrations, and otherwise rectify the
24 register with respect to the registrations of any party to the action." 15 U.S.C. § 1119.

25 42. Defendant's '602 Registration must be cancelled for all classes because
26 Defendant never made use in commerce the HOTBOX FARMS mark with all of the
27 listed goods/services, and it knew all statements otherwise were false when made.

28 43. As an alternate and separate reason, the '602 Registration must be cancelled

1 because Defendant only made ornamental use of the mark with the goods/services and it
2 did not function as a source identifier.

3 44. As yet another alternate and separate reason, the '602 Registration must be
4 cancelled because the specimens it submitted as part of its statement of use were
5 fabricated and stickers affixed to products of third parties and the HOTBOX FARMS
6 mark was not "printed" on the products as falsely declared to mislead and deceive the
7 USPTO, which statement was relied upon by the USPTO to issue the registration, and
8 Defendant knew the statements were false when made. At a minimum, the statements
9 were made and the specimens submitted with reckless disregard for the truth of the
10 statement and the authenticity of the specimens because the specimens were fabricated
11 and should have been properly investigated, thereby proving HFL intent to deceive the
12 USPTO.

13 45. As another alternate and separate reason, the '602 Registration must be
14 cancelled because Defendant misrepresented to the USPTO that it could rely on the IC 35
15 services as the secondary source to overcome the USPTO's refusal to register the mark in
16 classes 16, 21, 25, 26, and 34, when it knew that its IC 35 application was invalid because
17 it had not provided all of the goods listed on the application or because it knew that its
18 primary service was for the sale of marijuana and marijuana paraphernalia, which service
19 is not entitled to federal registration as it is in violation of the Controlled Substances Act.
20 Applicant concealed information concerning use of the HOTBOX FARMS mark in
21 connection with marketing and sale of unlawful drug paraphernalia, and by concealing
22 the information Defendant misrepresented to the USPTO that the services were being
23 provided lawfully in interstate commerce.

24 46. The statements to the USPTO were false, deceptive, and misleading when
25 made, made with the requisite intent to deceive the USPTO, and were relied upon by the
26 USPTO to issue the '602 Registration.

27 47. Puff TIW is being competitively harmed by the continued registration of
28 said mark.

1 48. Puff TIW has no adequate remedy at law and will be irreparably harmed
2 unless Defendant's conduct is preliminarily and/or permanently enjoined and the '602
3 Registration canceled. The Court should also order the registration of Puff TIW's
4 pending applications for the HOTBOX Trademarks listed above.

5
6 **THIRD CAUSE OF ACTION**

7 (Trademark Non-Infringement, Invalidity and Unenforceability)

8 49. Puff TIW refers to the allegations of Paragraphs 1 through 48 of this
9 Complaint and incorporates them as though fully set forth herein.

10 50. Puff TIW seeks declaratory relief from this Court to prevent Defendant
11 from hindering competition by illicitly monopolizing marks using the term "HOTBOX"
12 when Defendant has illicitly obtained the '602 Registration.

13 51. Defendant accused Puff TIW of infringing Defendant's alleged trademark
14 rights in HOTBOX FARMS as used for marijuana, under state registrations listed in
15 Exhibit A, and cigarette lighters.

16 52. Puff TIW seeks a declaratory judgment that its HOTBOX Marks do not
17 infringe on any of Defendant's purported HOTBOX FARMS marks, that Defendant's
18 registrations are invalid, their applications are void, and they have no enforceable
19 trademark rights.

20 53. Puff TIW has no adequate remedy at law.

21
22 **PRAYER FOR RELIEF**

23 WHEREFORE Puff TIW prays for judgment against Defendant, and each of them,
24 as follows:

25 A. That Defendant, their agents, servants, employees, representatives,
26 successors, and assigns, and all persons, firms, corporations, or other entities in active
27 concert or participation with any of them, be preliminarily and permanently enjoined
28 from:

- 1) threatening Plaintiffs, their customers, suppliers, distributors, and third parties in concert with them of infringement of any purported HOTBOX FARMS marks;
- 2) registering with the USPTO any pending or new trademark application containing the term “HOTBOX” as a word mark and/or design mark or any other colorable imitation of Plaintiffs’ HOTBOX Marks, including the HOTBOX related word marks and design marks that are likely to cause confusion, mistake, or deception or to impair the distinctiveness of Puff TIW’s HOTBOX Marks;
- 3) unfairly competing with Puff TIW in any manner; and
- 4) assisting, aiding, or abetting any other person or business entity in engaging in or performing any of the activities referred to in subparagraphs 1) through 4) above.

B. For an order finding that, by the acts complained of herein, Defendant has violated Section 1120 by obtaining the ‘602 Registration through fraud or misrepresentations, which they have used to damage Puff TIW;

C. For an order awarding, at Puff TIW’s election, statutory and/or actual damages, in an amount to be fixed by the Court in accordance with proof, including punitive and exemplary damages as appropriate, as well as all of Defendant’s profits or gains of any kind resulting from each cause of action, and further for an order awarding treble damages, pursuant to 15 U.S.C. § 1117(b) or any other applicable statute, because the acts of infringement were willful and wanton;

D. For an order directing the USPTO to cancel the ‘602 Registration and to allow the registration of Plaintiffs’ pending applications for the HOTBOX Marks;

E. For an order declaring that Puff TIW does not infringe Defendant’s purported rights in any HOTBOX FARMS or HOTBOX marks, Defendant’s asserted marks are invalid and/or void, and Defendant’s purported marks are unenforceable;

F. For an order declaring that any use by Puff TIW and/or its licensees of the

1 HOTBOX Marks does not, and will not, infringe any trademark rights of Defendant's and
2 that Defendant's trademarks are invalid and unenforceable;

3 G. For an order finding that an award of pre and post judgment interest is
4 necessary to fully compensate Puff TIW for the damage it has sustained;

5 H. For an order awarding Puff TIW relief based on Cal. Civ. Code § 3294;

6 I. For an order awarding Puff TIW all of its costs, including its attorneys' fees
7 incurred in prosecuting this action;

8 J. Awarding Puff TIW recovery for any unjust enrichment of Defendant; and,

9 K. For an order awarding Puff TIW such other and further relief as the Court
10 may deem just and proper.

11
12 Dated: September 22, 2023

Respectfully submitted,

13
14 **MILORD LAW GROUP P.C.**

15
16 /s/ Milord A. Keshishian
17 Milord A. Keshishian
18 Attorneys for Plaintiffs
19 TIW HOLDINGS LLC
20 PUFF LABS LLC
21
22
23
24
25
26
27
28

DEMAND FOR JURY TRIAL

Plaintiffs, through their attorneys of record, hereby demand trial by Jury.

Dated: September 22, 2023

MILORD LAW GROUP P.C.

/s/ Milord A. Keshishian

Milord A. Keshishian

Attorneys for Plaintiffs

TIW HOLDINGS LLC

PUFF LABS LLC